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In re Application of :
WEISS, Lawrence D., et al. :
U.S. Application No.: 09/807,443 : DECISION
Filing Date: 21 August 2001 :
Attorney's Docket No.: 374.37564X00 :
For: SYSTEM AND METHOD OF ADVISING :
BUYERS HOW MUCH TO PAY FOR GOODS :
AND SERVICES BASED ON DEMOGRAPHICS :

This decision is issued in response to the 21 August 2001 filing of: (1) "Petition," accompanied by a copy of the specification (including claims) and a \$130 fee; (2) "Petition To Grant Original Filing Date And Refund Of Fees," asserting that the original 25 April 2001 submission included the required specification and claims that the filing date for the application should therefore be 25 April 2001 and the \$130 petition fee should be refunded (this petition includes copies of the return postcards confirming applicants' 25 April 2001 submission); and (3) a "Letter To PCT Petitions Attorney Richard M. Ross."

BACKGROUND

The application materials originally filed by applicants on 25 April 2001 (which were submitted with two separate return postcards, two separate Fee Transmittal forms, and which referenced two separate attorney docket numbers) were treated upon filing as two separate applications. Application number 09/807,444 (attorney docket number 374.37564A00, hereinafter "A00"), was created as a national stage of PCT/US99/22904 filed under 35 U.S.C. 371. The petition to revive the application under 37 CFR 1.137(b) included with the application materials, and one of the Fee Transmittal forms (both of which contained the A00 docket number) were placed in the 09/807,444 application file, as was the copy of the international application and the related international stage papers. The \$620 petition fee and the \$65 surcharge for filing the declaration later than thirty months after the priority date, both of which were listed on the A00 Fee Transmittal form, were allocated to such application as well.

The Utility Patent Application Transmittal (Form PTO/SB/05), the second Fee Transmittal form, the formal drawings, and the preliminary amendment requesting entry of the formal drawings (all of which contained attorney docket number 374.37564X00, hereinafter "X00") were placed in present application number 09/807,443. Based on the Form PTO/SB/05, application number 09/807,443, which was created as a new utility application filed under 35 U.S.C. 111(a). The \$355 filing fee, and the \$893 in excess claims, all of which were listed on the

X00 Fee Transmittal form, were allocated to application number 09/807,443.

On 25 June 2001, the USPTO mailed herein a "Notification Of Incomplete Nonprovisional Application" indicating that the filed nonprovisional application was incomplete because it did not include a specification and claims.

On 21 August 2001, applicants filed in present application 09/807,443: (1) "Petition," accompanied by a copy of the specification (including claims) and a \$130 fee; (2) "Petition To Grant Original Filing Date And Refund Of Fees," asserting that the original 25 April 2001 submission included the required specification and claims that the filing date for the application should therefore be 25 April 2001 and the \$130 petition fee should be refunded (this petition includes copies of the return postcards confirming applicants' 25 April 2001 submission); and (3) a "Letter To PCT Petitions Attorney Richard M. Ross" considered herein.¹

On 24 October 2001, applicants filed in the present application a "Second Preliminary Amendment."

DISCUSSION

In the submission considered herein, applicants argue that the materials filed on 25 April 2001 should have been treated as a single application. However, based on applicants' submission of materials under two different attorney docket numbers, with separate Fee Transmittal forms and return postcards for each docket number, it is concluded that the USPTO acted properly in treating the 25 April 2001 submission as two separate applications: (1) a national stage filed under 35 U.S.C. 371, which included the petition to revive the application and the related international application materials (09/807,444), and (2) a utility application filed under 35 U.S.C. 111(a) (09/807,443).

The "Petition" filed 21 August 2001 includes a specification and claims and a \$130 petition fee, as required by the "Notification Of Incomplete Nonprovisional Application." Based on this submission, applicant is entitled to a filing date herein of 21 August 2001, with the specification and claims of record being those submitted with the petition on 21 August 2001.

The "Petition To Grant Original Filing Date And Refund Of Fees" filed 21 August 2001 asserts that applicants 25 April 2001 submission included 44 pages of specification (such specification including a total of 97 claims). As support, applicants have attached copies of the two return postcards included with the original 25 April 2001 submission. A review of these return postcards reveals that the postcard bearing the X00 docket number (stamped by the

¹ Also on 21 August 2001, applicants filed, in related application 09/807,444: (1) a "Renewed Petition Under 37 CFR 1.137(b);" (2) a "Petition To Refund Excess Fees Paid," and (3) a "Letter To PCT Petitions Attorney Richard M. Ross." These materials are treated separately in a decision issued concurrently herewith in application 09/807,444.

USPTO with the 09/807,443 application number) itemizes the following items: (1) \$1,248 in fees; (2) "New Application;" (3) a preliminary amendment; (4) 363 sheets of formal drawings; (5) Utility Application Transmittal; (6) Fee Transmittal; and (7) credit card payment form. This return postcard also bears what appears to be a USPTO notation stating that the "PTO did not receive 44 pages of specification." The 44 page specification is itemized on the second return postcard, which bears the A00 docket number and was assigned serial number 09/807,444 by the USPTO. In sum, these return postcards confirm that the copy of the 44 page specification was included with the materials filed under the A00 docket number, the materials that were assigned to application number 09/807,444. The materials filed under the X00 docket number, which were used to create the present application, did not include the specification. Accordingly, the mailing of the "Notification Of Incomplete Nonprovisional Application" herein was proper, and applicants are not entitled to the requested 25 April 2001 filing date. The proper filing date herein is therefore 21 August 2001, the date on which the present petitions, accompanied by a copy of the specification and claims, were filed in the present application. Because applicants are not entitled to the earlier filing date, the requested refund of the petition fee would not be appropriate.

It is noted that the declarations filed herein execute a different international application (PCT/US99/22909) and therefore are unacceptable.

CONCLUSION

Applicants' "Petition" submitted in response to the "Notification Of Incomplete Nonprovisional Application" mailed 25 June 2001 is **GRANTED**. The present application is accorded a filing date of 21 August 2001, the date that the petition and the accompanying specification (including claims) were submitted.

The "Petition To Grant Original Filing Date And Refund Of Fees" is **DISMISSED** without prejudice for the reasons discussed above.

This application is being forwarded to OIPE for further processing in accordance with this decision.



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